

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Docket No. 138065UL (MHM 15115US01))**

In the Application of:

Mathew

Serial No.: 10/681,634

Filed: October 8, 2003

For: BIOMETRICALLY ENABLED
IMAGING SYSTEM

Art Unit: 3737

Examiner: Ramirez, John Fernando

Confirmation No. 6101

Electronically Filed on May 19, 2008

REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Paper responds to the Examiner's Answer mailed May 11, 2009. The Applicant respectfully requests that the Board of Patent Appeals and Interferences reverse the final rejection of claims 1, 4-10, 13-14 and 16-19 and 21-23 of the present application for at least the reasons set forth in the Second Appeal Brief filed February 9, 2009 and the following:

Initially, the Applicant notes that the Examiner's Answer sets forth essentially the same arguments and reasoning as the Final Office Action. *Compare* Examiner's Answer at pages 3-6 with August 19, 2008 Office Action at pages 2-4. Thus, the Second¹ Appeal Brief responds to these arguments. *See* Second Appeal Brief at pages 6-12.

I. The Cited References Do Not Render The Pending Claims Unpatentable

The Examiner's Answer does add, however, the following:

Any biometric system works using three steps: 1) Enrollment: The first time you use a biometric system, it records basic information about you, like your name or an identification number. It then captures an image or recording of your specific trait. 2) Storage: most systems don't store the complete image or recording. They instead analyze your trait and translate it into a code or graph. Some systems also record this data onto a smart card that you carry with you, and 3) Comparison: The next time you use the system, it compares the trait you present to the information on file. Then, it either accepts or rejects that you are who you claim to be.

See Examiner's Answer at pages 6-7 (emphasis added). Notably, the Examiner's Answer provides no citations or evidence to support the statement that "Any biometric system works" using the various steps subjectively defined by the Examiner.

The Federal Circuit has stated that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness."

See the MPEP at § 2142 (emphasis added), citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006), and *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

¹ Note, the Examiner reopened prosecution after considering the First Appeal Brief filed July 30, 2007 and the Response to Notification of Non-Compliant Appeal Brief filed November 20, 2007.

As shown above, the Examiner's Answer merely subjectively concludes that "Any biometric system works" using the steps it subjectively defines, without offering any citation or evidence to support such statement. However, "rejections on obviousness cannot be sustained with mere conclusory statements." *See id.*

Additionally, the Examiner's Answer states that "[b]y the above **definition...**" *See* Examiner's Answer at page 7. However, the Examiner's Answer provides no objective "definition" of a biometric system. Instead, as demonstrated above, the Examiner's Answer merely provides subjective conclusions as to the nature of "Any biometric system...." Clearly, such subjective conclusions without evidentiary support cannot be considered an objective "definition."

The Office Action also states that

[A]ny Biometric system **inherently** discloses the steps of: "wherein biometric data extracted from the biometric identifier is compared with stored biometric data in said data storage unit" "wherein the stored biometric data is associated with stored personal identification information", and "wherein the stored biometric data and the stored personal identification information are stored after an initial registration".

See Examiner's Answer at page 7 (emphasis added). However, this statement in the Examiner's Answer is merely a sweeping generalization of what "**any** biometric system **inherently** discloses." *See* Examiner's Answer at page 7.

As explained in the Second Appeal Brief, none of the cited references, alone or in combination with one another, describes, teaches or suggests **associating user preference information with respect to imaging capabilities of a medical device with "stored biometric data and with the personal identification information."** *See* Second Appeal Brief at pages 7-12. The Applicant specifically explains how and why Kinicki does not overcome the

deficiencies of Hastings and ShamRao, acknowledged by the Office Action. *See* Second Appeal Brief at pages 9-12. Thus, for at least these reasons and those set forth above, the proposed combinations of references do not render any of the pending claims unpatentable.

II. A Prima Facie Case Of Obviousness Has Not Been Established With Respect To Claim 21 For An Additional Reason

Neither the Office Action nor the Examiner's Answer has shown where any of the references disclose "**allowing said registering step** by inputting a password," as recited in claim 21. *See* August 19, 2008 Office Action and Examiner's Answer. Indeed, the Office Action does not even address the language of claim 21. *See* August 19, 2008.

The Examiner's Answer notes, however, ShamRao at [0061]. *See* Examiner's Answer at page 8. However, this portion of ShamRao merely notes that "personalization data can include personal profile information including name, login id, passwords, address," *See* ShamRao at [0061]. While this portion of ShamRao indicates that a user may have a password, there is nothing in it that describes, teaches or suggests **allowing a registration** by using that password. That is, the Examiner's Answer, much like the Office Action, has not pointed to anything in the cited references that describes, teaches or suggests "**allowing said registering step** by inputting a password," as recited in claim 21. Thus, for at least these reasons, the Office Action has not established a prima facie case of obviousness with respect to claim 21.

III. CONCLUSION

As discussed in the Second Appeal Brief and above, the Applicant respectfully submits that the pending claims are allowable in all respects. Therefore, the Board is respectfully requested to reverse the rejections of pending claims 1, 4-10, 13-14 and 16-19 and 21-23.

Reply Brief
Serial No. 10/681,634

The Commissioner is authorized to charge any necessary fees (or credit overpayment) to
Deposit Account 07-0845.

Respectfully submitted,

Date: May 19, 2009

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